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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,610	07/23/2004	Tatsuya Kawakami	SIC-04-030	4357

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DELAND LAW OFFICE
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EXAMINER

JOHNSON, VICKY A

ART UNIT	PAPER NUMBER
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3656

NOTIFICATION DATE	DELIVERY MODE
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05/06/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

bdeland1992@gmail.com
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Office Action Summary	Application No. 10/710,610	Applicant(s) KAWAKAMI, TATSUYA	
	Examiner Vicky A. Johnson	Art Unit 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41, 43, 47, 49-58, 70, 72-78 and 80-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41, 43, 47, 49-58 and 90 is/are allowed.
- 6) ☒ Claim(s) 1-40, 70, 72-78 and 80-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Ose (US 5,768,945).

Ose discloses a shift control device for a bicycle transmission comprising: a mounting member (11) adapted to mount the shift control device to a bicycle; a first lever (4) operatively coupled to the mounting member wherein the first lever moves in a first plane (see Fig 2); a second lever (10) operatively coupled to the mounting member for movement in a second plane between a rest position and an operating position such

Art Unit: 3656

that the second lever returns to the rest position after moving to the operating position; wherein the first plane is substantially parallel to the second plane (see Fig 2); a positioning unit (3) that rotates to and is maintained in a plurality of positions corresponding to gear positions of the bicycle (col. 4 lines 23-65); and a positioning member (16) that moves relative to the second lever and that is controlled by the second lever to operate the positioning unit, the first lever rotates within the first plane (see Fig 2), the second lever rotates within the second plane (see Fig 2), the positioning unit moves to the plurality of positions corresponding to gear positions of the bicycle in response to movement of the first lever and the second lever (col. 3 lines 28-34), the positioning member maintains the positioning unit in each of the plurality of positions corresponding to gear positions of the bicycle (the end position being interpreted as the original position, col. 3 line 64 – col. 4 line 11), wherein the first lever is operatively coupled to the positioning unit so that the first lever is maintained in a plurality of positions corresponding to gear positions of the bicycle transmission in addition to beginning and end positions of a range of motion of the first lever (col. 3 line 34 – col. 4 line 22), a motion limiting member (9) that limits movement of the positioning unit in response to movement of the second lever (col. 4 lines 53-55), the first lever and the second lever are coupled to the mounting member such that the first lever and the second lever are located above the bicycle handlebar when the shift control device is mounted to the bicycle handlebar (see Fig 1).

3. Claims 70, 72-78, and 80-93 are rejected under 35 U.S.C. 102(e) as being anticipated by Wessel (US 7,194,931).

Wessel discloses a bicycle control apparatus comprising: a mounting member (5) adapted to be mounted to a bicycle; a positioning unit (1, 6) coupled to the mounting member for moving to a plurality of positions (col. 2 lines 60-65); a positioning member (9) that maintains the positioning unit in each of the plurality of positions; wherein the positioning member moves along a first path between an engagement position (see Fig 1), where the positioning member engages the positioning unit, and a disengagement position (see Fig 2) where the positioning member is disengaged from the positioning unit; and wherein the positioning member (9) moves along a second path that is different from the first path (see Figs 1 and 2), and wherein movement of the positioning member along the second path includes movement of the positioning member (sliding movement, in regard to movement to the left or right) other than rotation of the positioning member (see Figs 1 and 2).

Allowable Subject Matter

4. Claims 41, 43, 47, 49-58 and 94 are allowed.

Response to Arguments

Some further comments regarding the applicant's remarks are deemed appropriate.

The applicant argues that the Ose reference fails to meet the limitations of the claims because it fails to disclose the first lever being maintained in a plurality of positions corresponding to gear positions of the bicycle transmission in addition to beginning and end positions of a range of motion of the first lever. Ose is being broadly interpreted as having a first lever having a range of motion where the first lever has a

Art Unit: 3656

beginning position, at least one intermediate position, and an end position. The first lever of Ose is maintained in the first position and the end position. There is no limitation in claim 1 that the beginning position and the end position have to be different positions. Therefore, the Ose reference meets the limitations of the claims.

The applicant's remarks have been accorded due consideration, however, they are not deemed fully persuasive.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vicky A. Johnson whose telephone number is (571) 272-7106. The examiner can normally be reached on Monday-Friday (7:00a-3:30p).

Art Unit: 3656

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vicky A. Johnson/
Primary Examiner, Art Unit 3656